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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/533,029	03/22/2000	Jacqueline Heard	MB1-0010	7823

7590

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EXAMINER

KRUSE, DAVID H

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 07/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/533,029

Applicant(s)

HEARD ET AL.

Examiner

David H Kruse

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 June 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 09 June 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☒ Newly proposed or amended claim(s) 37-60 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ ^{has been} ~~will be~~ entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 37-60.Claim(s) objected to: 62 and 69.Claim(s) rejected: 61, 63-68 and 70-76.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet

Continuation of 3. Applicant's reply has overcome the following rejection(s): 35 USC 112, first paragraph for claims 37-60, 62, and 69 and 35 USC 103(a) for claims 37, 38, 40-42, 45, 46, 48-50, 53, 54 and 56-58.

Continuation of 5. does NOT place the application in condition for allowance because: Claims 61, 63-68 and 70-76 remain rejected under 35 USC 112, first paragraph and 35 USC 103(a) as stated in the previous Office action mailed 8 January 2003. Applicant's arguments filed 6 June 2003 have been considered but are not found to be persuasive. Applicant's arguments on pages 10-12 of the Response as directed to the rejection under 35 USC 112, first paragraph for written description have been considered but are not found to be persuasive in the instant case because, as directed to plant transcription factors, the description of a transcription factor polypeptide does not inherently describe those polynucleotides that would bind under high stringency conditions to a polypeptide that encodes the described transcription factor polypeptide. Even within a transcription factor family, the specific function is not defined by the polypeptide's structure as directed to those genes or traits that are regulated by a transcription factor within said family. Applicant's arguments on pages 14-17 of the response as directed to the rejection under 35 USC 112, first paragraph, for enablement, Applicant argues that the teachings of Zhou (1997) enable the breadth of the claimed invention. This argument is not found to be persuasive because it is pursuant upon Applicant to enable the claimed invention, and Applicant is required to teach how to make and use the invention within the full breadth of the claims such that one of skill in the art would readily recognize what the claims cover. See *Amgen inc. v Chagai Pharmaceutical co.*, 18 USPQ 2d 1016 (Fed. Cir. 1991), which teaches that the conception of a chemical compound requires the inventor to be able to define the compound so as to distinguish it from other materials, and to describe how to obtain it rather than simply defining solely by its principle biological property; thus, when an inventor of a gene, which is a chemical compound albeit a complex one, is unable to envision detailed constitution of the gene so as to distinguish it from other materials, as well as a method of obtaining it, the conception is not achieved until a reduction to practice has occurred, and until after the gene has been isolated. In addition, it is necessary that the inventor provide a disclosure sufficient to enable one skilled in the art to carry out the invention commensurate with the scope of the claims, for DNA sequence that means disclosing how to make and use enough sequences to justify grant of the claims sought. Applicant's arguments as directed to the rejection under 35 USC 103(a) on pages 18-19 of the Response have been considered. Applicant argues that Zhou does not teach tolerance to a fungal disease due to the expression of Pti4 (page 18, 2nd paragraph of the Response), but on page 14, last paragraph, of the Response Applicant argues that Zhou enables nucleotide sequences encoding a transcription factor that hybridizes under high stringency conditions to one encoding residues 145-213 of SEQ ID NO: 18. Given the teachings of Zhou and the breadth of the rejected claims, one of ordinary skill in the art at the time of Applicant's invention would have had a reasonable expectation of success in isolating the polynucleotide taught by Zhou under the conditions claimed by Applicant. In addition Zhou motivates one of ordinary skill in the art to make transgenic plants that would have tolerance to fungal disease, including Fusarium, because the Pti4 transcription factor. Zhou teaches that Pti4 can be used to enhance PR gene expression and disease resistance in transformed plants, including fungal disease (page 3214, left column, 2nd paragraph).

As directed to the provisional Double Patenting rejections over copending applications 90/713,994 and 09/934,445, the Examiner notes that neither application has been allowed at the time of this Office action. Said Double Patenting rejections would be moot if Applicant cancels the rejected claims, and does not present any amendment that would lead to new rejections of those claims that are indicated as allowable.

Continuation of 10. Other: Applicant's request that the finality of the Office action mailed 8 January 2003 be withdrawn in view of the new rejection under 35 USC 103(a) has been considered but is not found to be persuasive because said Office action clearly states that the new rejection was necessitated by Applicant's amendments. The indefiniteness of the claims originally presented and addressed in the Office action mailed 29 May 2002 was such that how the claims read on the prior art was unclear. See *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962). There the court pointed out that, before the claimed subject matter could properly be compared to the prior art, it was essential to know **what the claims did in fact cover**.

Claims 62 and 69 are objected to as being dependent upon a rejected base claim. Claim 62 and 69 would be objected to under 37 CFR 1.75 as being a substantial duplicate of claims 39 and 55 respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

DAVID T. FOX
PRIMARY EXAMINER
GROUP 180

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